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| 10/813,007 | 03/31/2004 | Tetsuya Morokawa | 251308US2TTCX | 5236 |
| 22850 | 7590 | 02/03/2009 | | |
| OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | EXAMINER LARYEA, LAWRENCE N | |
| | | | ART UNIT 3768 | PAPER NUMBER |
| | | | NOTIFICATION DATE 02/03/2009 | DELIVERY MODE ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/813,007

Applicant(s)

MOROKAWA ET AL.

Examiner

LAWRENCE N. LARYEA

Art Unit

3768

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Examiner acknowledges Applicant's amendment and remarks filed 27 June 2007.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Chapelon et al (Patent 6,071,238).
3. Re Claims 1-2, and 12: Chapelon et al teach an ultrasonic probe for insertion into an endocavity of a specimen in order to examine the specimen, comprising: a holding portion including a first housing portion **(1)** ; an insertion member **(4)** configured to move along the first housing portion, and an ultrasonic generator **(3)** provided at the one end of the insertion member and configured to transmit an ultrasound pulse to the specimen and collect an echo signal resulting from the transmitted ultrasound pulse wherein the holding portion is coupled to the ultrasonic generator, so that a position of the ultrasonic generator is adjustable in accordance with an angle of the holding portion **(See Figs 1-16)**.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Capelon et al** in view of **Vaezy et al (US Patent 6,716,184)**.
6. **Chapelon et al** teach the claimed invention see supra rejection but **Capelon et al** does not teach that a display unit is coupled to ultrasound probe.
7. **Vaezy et al** teach an ultrasonic probe for insertion into an endocavity of a specimen in order to examine the specimen, comprising: a holding portion including a first housing portion; an insertion member configured to move along the first housing portion, and an ultrasonic generator provided at the one end of the insertion member (**See Figs 9A-11**) and a display (**202**) is coupled to ultrasound probe (**212**) to aid a clinician to easily visualize and distinguish different (treatment) sites during the ultrasound treatment procedures (**See Col.13, lines 25-60**).

It would have been obvious to one having ordinary skill in the art at the time invention was made to modify the ultrasonic probe for insertion into an endocavity of a specimen in order to examine the specimen of **Capelon et al** to include a display unit of **Vaezy et al** in order to help to aid a clinician to easily visualize and distinguish different (treatment) sites during the ultrasound treatment procedures as taught by **Vaezy et al**.

8. Claims 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Capelon et al** as applied to claim 1 above, and further in view of Kubota et. al (US Patent 5255669 **as previously cited**).

9. **Capelon et al** teach the claim invention except for a plurality of first projections around a surface of the insertion member along a longitudinal direction of the insertion member and that the holding portion includes a second projection.

In the same field of endeavor Kubota teaches an ultrasonic treatment apparatus which includes an ultrasonic probe having two pairs of projections (col. 12 lines 58-61). Furthermore, according to Kubota , the number of projections are not limited to two pairs, but a larger number of projections may be formed (col. 12 lines 65-67).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teaching of Webler with the teaching of Kubota in order to provide that insertion member of the probe mounted in parallel sliding relation to the body of the housing can be engaged and moved by the practitioner fingers(s) and thereby allow a physician to exercise manual control over the longitudinal positioning of the probe.

Response to Amendment

10. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

Claims 1-12 are now pending. The Examiner acknowledges the amendments to Claims 1,11,12 as well as the cancellation of Claim 13.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **LAWRENCE N. LARYEA** whose telephone number is (571)272-9060. The examiner can normally be reached on 9:30 a.m.-5:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

LNL

/Eric F Winakur/
Primary Examiner, Art Unit 3768